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| 09/691,352      | 10/18/2000  | Duane M. Pinault     | 55126USA3A.002      | 3971             |

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EXAMINER

NORDMEYER, PATRICIA L

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1772

5

DATE MAILED: 08/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/691,352

Applicant(s)

PINAULT ET AL.

Examiner

Patricia L. Nordmeyer

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 20-25 and 32-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19, 26-31 and 35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Group 1, claims 1-19 and 26 - 31 in Paper No. 4 is acknowledged. Claims 20 – 25 and 32 – 34 were not elected for prosecution as non-elected inventions.

### ***REPEATED REJECTIONS***

2. The 35 U.S.C. 112 rejection of claims 8 and 9 is repeated for the reasons previously of record in Paper #3, Pages 3 – 4, Paragraphs 7 – 8.

### ***WITHDRAWN REJECTIONS***

3. The 35 U.S.C. 112 rejection of claims 6, 13 and 18 of record in Paper #3, Pages 3 – 4, Paragraph 9 have been withdrawn due to Applicant's amendments and arguments in Paper #4.

4. The 35 U.S.C. 103 rejection of claims 1 – 7, 10, 12 – 16 and 26 – 29 of record in Paper #3, Pages 4 – 6, Paragraphs 11 – 16 has been withdrawn due to Applicant's arguments in Paper #4.

5. The 35 U.S.C. 103 rejection of claims 8 and 9 of record in Paper #3, Page 7, Paragraphs 17 - 21 has been withdrawn due to Applicant's arguments in Paper #4.

Art Unit: 1772

6. The 35 U.S.C. 103 rejection of claims 11, 17 – 19 and 30 – 31 of record in Paper #3, Pages 8 and 9, Paragraphs 22 – 27 has been withdrawn due to Applicant's arguments in Paper #4.

### ***NEW REJECTIONS***

#### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 8 and 9 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is unclear from the specification what the coordinates L\*, a\* and b\* stands a intensity or brightness or color when using the HunterLab color scale. No explanation is given in the specification.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. The terms "ASTM D-228-00" and "ASTM D-882.97" in claims 2, 5, 14, 15 and 19 are relative terms which render the claims indefinite. The terms "ASTM D-228-00" and "ASTM D-882.97" are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Clarification/correction is required.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1, 3, 4, 6, 7, 10 – 13, 16 – 18, 26, 27, 30, 31 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Tsuei (USPN 5,783,303).

Tsuei discloses an article with a plurality of ceramic granules (Column 11, lines 47 – 51 and Figure 1, #16) bonded to a polymeric film (Column 11, lines 28 – 30 and Figure 1, #11) by a radiation curable (Column 4, lines 41 – 44) aliphatic urethane acrylic copolymer (Column 4, lines 30 – 31). A variety of items may be added to the curable coating including pigments, dyes, ultraviolet absorbers, ultraviolet scavengers, fillers and adhesion promoters (Column 7, lines 26 – 37). In order to improve adhesion to the coatings, the film may be primed (Column 11, lines 43 – 45). The article may also be formed a free-standing coating with a layer of adhesive to attach particles to the surface (Column 12, lines 26 – 45). A size coating, sealant, of varying thickness is placed over the particles, completely covering some of the particles, and adhesive layer to help bond the particles to the film (Column 10, lines 39 – 59). The article may be used as a floor covering (Column 9, lines 59 – 64).

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 2, 5, 8, 9, 14, 15 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuei (USPN 5,783,303).

Tsuei discloses a product with white ceramic granules (Column 11, line 52) adhered to a film with transparent adhesive (Column 10, lines 63 – 65) that was tested for flexibility, pliability, (Column 25, lines 14 – 24) and had a tensile elongation of 112% (Column 25, lines 37 – 40).

Regarding determining the pliability of the product by mandrel flexibility test procedures according to ASTM D-228-00, the flexibility tested according to ASTM D-882.97, the aesthetic color being changed as indicated by one unit or more of change in an HunterLab color coordinates of L\*, a\* or b\* and the product exhibiting a value of 64 or greater for L\* according to HunterLab spectrophotometer test procedures in claims 2, 5, 8, 9, 14, 15 and 19, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product

Art Unit: 1772

was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation of using ASTM D-228-00, ASTM D-882.97 and HunterLab color coordinates and spectrophotometer test procedures is a method of production and therefore does not determine the patentability of the product itself. Process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

15. Claims 1, 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zickell (CA 2,270,684) in view of George et al. (USPN 5,516,573).

Zickell discloses a roofing shingle (Page 3, lines 19 – 20) with grit (Figure 2, #22) embedded in an adhesive such as epoxy, polyester or polypropylene (Page 5, lines 1 – 3). A film made from polyethylene is adhered to the opposite side of the adhesive as a support layer (Page 4, line 30). However, Zickell fails to disclose ceramic coated granules and a the tensile strength according to American Roofing Manufacture Association Test Index No. 2,126 of greater than 50% over a shingle without said integrated granule product.

Art Unit: 1772

George et al. teaches ceramic-coated granules (Column 3, lines 8 – 12) on the surface of a roofing material (Figure 3, #63 and Column 2, lines 46 – 47) for the purpose of giving protection against exposure from ultraviolet light and improve fire resistance and weather characteristics.

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the ceramic coated granules in Zickell in order to give protection against exposure from ultraviolet light and improve fire resistance and weather characteristics as taught by George et al. since Zickell already contained a type of gritted material.

Regarding claim 29, since Zickell in view of George et al. discloses the same materials, a polymeric film and hot melt adhesive, as desired by the applicant, it is inherent that the roof shingle exhibits a tensile strength of greater than 50% over a shingle without the integrated granule product according to American Roofing Manufacturers Association Test Index No. 2,126.

#### ***ANSWERS TO APPLICANT'S ARGUMENTS***

16. Applicant's arguments filed in Paper #4 regarding the 35 U.S.C. 112 rejection of record of claims have been fully considered but they are not persuasive.

In response to Applicant's argument that the HunterLab coordinate are very well known in the art, the name of the equipment, HunterLab, is still a formal name of the equipment itself or



Art Unit: 1772

the company which makes the equipment. The trademark or trade name does not identify the equipment or describe the goods associated with the trademark or trade name. The trademark/trade name is used to identify/describe a spectrophotometer and accordingly, the identification/description is indefinite.

17. Applicant's arguments filed in Paper #4 regarding the 35 U.S.C. 103 rejection of claims 1 – 7, 10, 12 – 16 and 26 – 29 in view of George et al. in view of Katsamberis have been considered but are moot since the rejections have withdrawn.

12. Applicant's arguments filed in Paper #4 regarding the 35 U.S.C. 103 rejection of claims 8 and 9 in view of George et al. in view of Katsamberis and further in view of Weaver et al. have been considered but are moot since the rejections have withdrawn.

13. Applicant's arguments filed in Paper #4 regarding the 35 U.S.C. 103 rejection of claims 11, 17 – 19 and 30 - 31 in view of George et al. in view of Katsamberis and further in view of Thomas et al. and Kalkanoglu have been considered but are moot since the rejections have withdrawn.

### ***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 1772

U.S. Patent No. 5,053,253 to Haenggi and U.S. Patent No. 4,871,376 to DeWald are cited to show the state of the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (703) 306-5480. The examiner can normally be reached on Mon.-Thurs. from 7:00 -4:30 p.m. & alternate Fri..

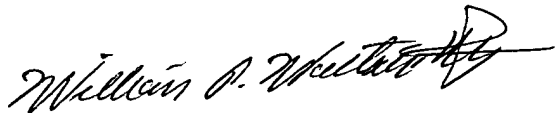
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (703) 308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Patricia L. Nordmeyer  
Examiner  
Art Unit 1772

*pln*  
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August 15, 2002



WILLIAM P. WATKINS III  
PRIMARY EXAMINER